

## **REMARKS**

Claims 1, 3-7, 9-17, 19-25, 27-31, 33-38, 40, 41, 43-51 and 53-55 were pending and presented for examination in this application. In an Office Action dated April 17, 2007 claims 1, 3-7, 9-17, 19-25, 27-31, 33-38, 40, 41, 43-51 and 53-55 were rejected. Applicants address the Examiner's comments below. Applicants are amending claims 1, 25, 49, and 53 in this Amendment and Response and adding new claims 57-64. These changes do not introduce new matter, and their entry is respectfully requested. In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding objections and rejections, and withdraw them.

### **Premature Finality of Office Action**

The Office Action mailed April 17, 2007 was prematurely made final because claims 49-51 were rejected on newly cited art (U.S. Patent No. 5,555,346 to Gross, et al.) and these claims were not previously amended by the Applicants. As recited in MPEP 706.06(a) ¶ 2:

“...a second or any subsequent action on the merits in any application...will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.”

In a voicemail received by Applicants' representative on June 25, 2007, the Examiner stated that he had consulted with his supervisor, Zarni Maung, and agreed that the finality of the Office Action was improper. The Examiner further indicated that he would issue a new non-final Office Action. In a follow up phone call on July 18, 2007, the Examiner requested that Applicants make the reasons discussed above

of record in a written response and indicated he would remove the finality of the Office Action upon receipt of the response. Accordingly, Applicants expect that the Amendments and remarks presented herein will be entered and considered by the Examiner.

### **Claims 15 and 39 Not Addressed in Office Action**

In the Office Action mailed on April 17, 2007 the Examiner fails to address claims 15 and 39. As recited in MPEP 707.07(i), “In every Office action, each pending claim should be mentioned by number, and its treatment or status given.” Therefore, the Office Action is improper. In order to expedite prosecution, however, Applicants address the Examiner’s rejection to the remaining claims below. Applicants request that the Examiner indicate the status of claims 15 and 39 in the next Office Action.

### **Response to Rejections Under 35 USC 103(a)**

The Examiner rejects claims 1, 3-14, 16-17, 19-25, 27-31, 33-38, 40-41, 43-51, and 53-55 under 35 USC § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0059425 A1 to Belfiore, et al. (“Belfiore”) in view of U.S. Patent No. 5,555,346 to Gross, et al. The rejection is now respectfully traversed.

Representative claim 1, as amended, recites:

...associating the email event with a conversation based at least in part on the event data, **wherein the conversation comprises a thread of related email messages;** and  
storing the email event, the association with the conversation, and the email message.

Claim 25, 49, and 53 recite similar claim language. The claimed invention determines the occurrence of a condition that indicates a transfer of an email message by an email application. Event data associated with the email message is identified and an email event is compiled from the event data. The email event is associated with a conversation comprising a thread of related email messages and the event, the association with the conversation, and the email message are stored. The method is advantageous because, for example, it stores a convenient organization of past email correspondences so that related messages can be easily accessed.

The claimed invention would not have been obvious to a person of ordinary skill in the art at the time of the invention considering the references either alone or in combination because neither reference discloses or suggests associating an email event with a conversation comprising a thread of related email messages as recited in the claims. Belfiore discloses a distributed computing services platform that uses an eXtensible Markup Language (XML) to facilitate communication between servers and/or client devices. As indicated by the Examiner, Belfiore fails to expressly disclose several features of the claimed invention including, "...associating the email event with a conversation based at least in part on the event data; and storing the email event, the association with the conversation and the email message."

Gross also fails to disclose or suggest associating an email event with a conversation, wherein the conversation comprises a thread of related email messages. The Examiner points to FIG. 3I as allegedly disclosing associating an email event with a conversation. However, the "conversation" referred to in Gross is entirely different than the "conversation" recited in the claimed invention. As disclosed at, for example, col. 7 lines 1-7 of Gross, the term

“conversation” is used to mean a “dynamic data exchange” between two applications (e.g., a mail messaging system and a DDE server application). This is entirely unrelated to a conversation comprising a thread of related email messages as recited in the claims.

Therefore, at the time of the invention, the claimed invention would not have been obvious to a person of ordinary skill in the art in view of Belfiore and Gross, either alone or in combination. The dependent claims incorporate all the limitations of their respective base claims and are patentable for at least the same reasons as above.

### **Conclusion**

In sum, Applicants respectfully submit that claims 1, 3-14, 16-17, 19-25, 27-31, 33-38, 40-41, 43-51, 53-55 and 57-64 as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them. In addition, Applicants respectfully invite Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,  
DAVID B. AUERBACH, et al.

Date: August 16, 2007

By: /Jason E. Amsel/

Jason E. Amsel, Registration No. 60,650  
Patent Agent  
FENWICK & WEST LLP  
801 California St.  
Mountain View, CA 94041  
Phone: (650) 335-7692  
Fax: (650) 938-5200

24207/10111/DOCS/1726653.1